

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	: 10/542,223	Confirmation No.	: 3093
First Named Inventor	: Olli TIITU		
Filed	: July 14, 2005		
TC/A.U.	: 3749		
Examiner	: Stephen Gravini		
Docket No.	: 101908.56491US		
Customer No.	: 23911		
Title	: ROTATING STEAM DRYING APPARATUS		

PRE-APPEAL BRIEF CONFERENCE REQUEST

Appellant requests review of the rejections set forth in the Final Office Action dated November 23, 2009 ("Final Office Action"), which maintained the rejections set forth in the Office Action dated June 22, 2009 ("June 22nd Office Action"). No amendments are being filed with this Request, and this Request is being filed with a Notice of Appeal. For the reasons set forth below, Appellant submits that the rejections in the Final Office Action are defective and should be withdrawn.

I. Rejection of Claims 1 – 6

In the Final Office Action, the Examiner maintains the contention that claims 1 – 6 are anticipated by U.S. Patent 2,932,091 ("Day"). However, Appellant submits that Day suffers from numerous deficiencies. Specifically, in Day, the material to be dried is positioned over the external surface of the drum ("the drying of the web of paper passing over the external surface of the drum as in the drying end of a paper-making machine." Day, col. 1, ll. 15 – 20). In contrast, claim 1 expressly recites "material to be dried is fed to a first end of the drying apparatus, the material being arranged to be discharged through a second end of the drying apparatus." Day provides no teaching or suggestion for this arrangement as it is designed to dry material "passing *over* the external surface of the drum" rather than *through* the drum. There is no disclosed structure which would even be capable of passing the material to be dried through Day's roll/shell **13** as tube **14** must be used to carry steam in order for the invention of Day to function.

In the Office Action, the Examiner has erroneously equated the recited “heat transfer element” with the “circular header tube **17** joined to the inner periphery of one end of the roll.” (Day, Col., 4, 14 – 16). However, the “heat transfer element” of claim 1 is not recited as being merely any heat transfer element. Rather, the “heat transfer element” is expressly and specifically recited as included each of the (1) “support structure,” (2) “longitudinal pipes,” and (3) “connecting pipes.” As such, there is no reasonable reading of Day that the circular header tube **17** equates with the recited “heat transfer element,” including the embodiment of Day in which “the steam header **17** is positioned intermediate the ends of the roll” Thus, neither the function nor the structure of the disclosed steam header **17** in Day could satisfy each of the claimed limitations corresponding to the recited “heat transfer element.”

Appellant further notes that Day fails to teach or suggest attaching longitudinal pipes fixedly to a support structure, and then attaching the support structure to the drum using fastening that allows for heat expansion, as recited in claim 1. Day is clear that the “plurality of disc-like frames **23** . . . have their outer edges bonded with the shell **13**.” (Day, col. 4, ll. 62 – 64), which is exactly the kind of deficiency in the prior art to which at least some aspects of the present invention are directed. In particular, the “abrading place in the drying apparatus is not an individual pipe but a support structure of the heat transfer element packet, connecting the drum frame with fastening that allows heat expansion,” as expressly noted in the pending application. See Specification, ¶ [0007].

Additionally, Appellant notes that tubes **22** of Day “are bonded in good heat-conducting relation to the roll body **13**, preferably by welded joints.” Col. 4, ll. 20 – 21 (*emphasis added*). This arrangement is in direct contradiction and in fact teaches away from the recited arrangement of claim 1 in which the longitudinal pipes are fixedly connected to a support structure, and then the support structure is attached to the drum using fastening that allows for heat expansion. Thus, the

tubes **22** in Day can not reasonably be equated with the recited longitudinal tubes. The same deficiency exists with respect to Day's disc-like frames **23**.

Additionally, the examiner is equating roll **13** of Day with the recited support structure. See Office Action, page 6. However, Day is clear that the roll **13** is the drum itself. Day even repeatedly refers to element **13** as being the shell **13**. See e.g., Day, col. 4, line 23, 31 & 70. However, claim 1 recites that the "heat transfer element" is "rotated within and with the drum," and that this same "heat transfer element comprises a support structure" Perhaps more importantly, the support structure of claim 1 is recited as being "attached to the drum." Thus, the recited "support structure" must be distinct from and within the drum, and cannot reasonably be interpreted as being the drum or shell itself. Therefore, Day fails to anticipate the pending independent claims and that the rejection of such is improper and should be withdrawn.

II. Restriction Requirement

The Restriction Requirement as between Group I (claims 1 – 8) and Group 2 (claims 9 – 14) has been made final. However, for the reasons set forth below, Appellant traverses the Restriction Requirement on the grounds that the Examiner has not provided sufficient evidence to establish that the claims of Group I are distinct from the claims of Group I. Nor has the Examiner provided sufficient evidence that there would be an examination and search burden because the species require a different field of search and/or applicable prior art applicable.

Restriction is proper only when the claims are distinct and there would be a serious burden to search and examine the claims in a single application. The criteria for establishing distinctness are set forth in M.P.E.P. § 806.05(c), which states that:

"[t]he inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in another materially different combination.”

Appellant submits that the Examiner has not established either of these two criteria (A) or (B). The only support provided by the examiner is that the “subcombination of group I has separate utility such as longitudinal pipes fixedly connected to a support structure.” (June 22nd Office Action, page 2). However, Group II correspondingly recites “a first support structure rigidly connected to and supporting the first set of longitudinal pipes.” It is unclear how these subcombinations could be deemed distinct and nonobvious variants, let alone having separate utility since what is recited are longitudinal pipes fixedly connected to a support structure, on the one hand, and a support structure that is rigidly connected to and supporting a set of longitudinal pipes, on the other hand. In short, A + B is not distinct from B + A. Moreover, the fact that the support structure and longitudinal pipes are recited as being *fixedly* connected in Group I versus *rigidly* connected in Group II is clearly insufficient to show distinctiveness. Similarly, the fact that the “support structure” in Group II is expressly recited as supporting the longitudinal pipes similarly does not create distinctiveness as it would be obvious to anyone that a support structure would perform a supporting function.

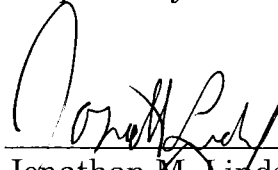
Furthermore, there is no showing in the Restriction Requirement that the invention of Group I has a separate utility from that of the invention of Group II. For example, even if “*fixedly* attached” were nonobviously distinct from “*rigidly* attached,” there is no showing as to how this would impart separate utility. Therefore, Appellant submits that the Examiner has not established either criteria (A) nor criteria (B) set forth above for showing distinctiveness.

The Restriction Requirement claims that there is an examination and search burden because the species require a different field of search and/or prior art applicable to one species would not likely be applicable to another species. However, as discussed in M.P.E.P. § 803, to support the Restriction Requirement, "Examiners **must** provide reasons and/or examples to support conclusions." M.P.E.P. § 803 II (*emphasis added*). Accordingly, "For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown ** by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02." M.P.E.P. § 803 II.

The Restriction Requirement identifies a separate subclass, but fails to explain why separate subclasses are necessary. Thus, the Patent Office has not provided an "appropriate explanation of separate classification." The Restriction Requirement also does not include an "explanation of . . . separate status in the art, or a different field of search." Because the Restriction Requirement has not provided any reasons or examples to support the conclusion that there would be a serious burden if restriction was not required, the Patent Office has not satisfied one of the basic criteria for a proper restriction requirement, and this Restriction Requirement is therefore improper and should be withdrawn.

Respectfully submitted,

Dated: February 12, 2010



Jonathan M. Lindsay
Registration No. 45,810

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (949) 263-8400
Facsimile No.: (202) 628-8844
JML/jmh
IR4379728